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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,468	05/02/2001	Gideon A. Yuval	MSI-755US	6947

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EXAMINER

PATEL, JAYANTI K

ART UNIT	PAPER NUMBER
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2625

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DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/848,468

Applicant(s)

YUVAL, GIDEON A.

Examiner

Jayanti K. Patel

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Drawings***

1. The drawings filed on May 2, 2001 are approved.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2, 4-11, 13-28, 30-31, 33-35 and 37-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Downs et al. (US 6,574,609).

As to claim 1, Downs discloses a secure electronic content management system comprising: a processor configured to process a digital content file; memory (column 9, lines 12-26); an authentication module configured to access a certificate associated with the digital content file and determine if the processor authorized to process the digital content file (column 14, lines 40-65).

Regarding claim 2, Downs discloses the electronic device comprising watermark detector configured to detect the presence of a watermark signal in the digital content file, and wherein the authentication module is further configured to access the certificate

associated with the digital content file if the watermark detector detects the watermark signal (column 8, lines 12-29).

As to claim 4, Downs discloses the electronic device wherein the certificated associated with the digital content file may be played but not copied; and the authorization module is further configured to limit the processor to playing the digital content file (column 7, line 65 through column 8, line 20).

As to claims 5-7, Downs discloses authentication module configured to prevent the processor from playing the digital content file after the specified date (column 14, lines 40-50) and only one time (column 8, lines 1-10). Additionally, such access restrictions are customary and are designed into any digital content file for secure processing of digital data distribution.

As to claims 8-10, Downs discloses the digital content file being an audio/video file (column 8, lines 50-60).

As to claims 11, 13-16, the steps claimed as method is nothing more than restating the function of the specific components of the apparatus as claimed above (including electronically transmitting the digital content file over the network being disclosed by Downs, column 46, lines 17-43) and therefore, it would have been obvious, considering the aforementioned rejection for the apparatus claims 1-2, 4-10.

As to claims 17-28, 30-31, 33-34, claims 17-28, 30-31, 33-34 substantially very similar limitations as claims 1-2, 4-11 and 13-16 above and are similarly analyzed.

As to claims 35, 37-42, Downs discloses a detailed procedure that describes the claimed limitations of processing digital certificate in a network/internet environment

(column 7, line 35 through column 8, line 29). Additionally, most of the limitations recite routine steps performed to authenticate and distribute digital content file over Internet/network.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3, 12, 29, 32, 36 and 43-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downs et al. (US 6,574,609) as applied to claims 1-2, 4-11, 13-28, 30-31, 33-35 and 37-42 above, and further in view of Yoshida et al. (US 6,674,874).

Regarding claims 3, 12, 29, 32, 36 and 43, while Downs discloses digital Watermarks being embedded in digital content file without specific details regarding 1-bit watermark.

In the same field of endeavor, however, Yoshida discloses a digital watermark embedding system comprising the step of embedding 1-bit watermark (column 1, lines 38-52).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to embed 1-bit watermark as taught by Yoshida in the system of Downs because it provides a digital watermark technique for integratedly managing a plurality of kinds of contents such as still images, motion images, audio, sound.

As to claims 44-47, Downs discloses audio, video, multimedia content and the location of the certificate (column 7, line 35 through column 8, line 64).

***Other prior art cited***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ginter et al. (US 6,640,304) discloses a system for secure transaction management.

Hobson et al. (US 6,633,653) discloses a system for watermarking digital images.

Matsui et al. (US 6,425,082) discloses a process of embedding watermark information in one-dimensional source data.

Wu et al. (US 6,285,775) discloses a watermarking scheme for image authentication.

Ratnakar (US 6,556,688) discloses a system that embeds hidden information like digital watermarks and digital fingerprints into an image.

DeBry (US 6,385,728) discloses a system that uses certificates to guarantee authorization to a digital file in a network.

Milsted et al. (US 6,345,256) discloses an automated system to package digital content for electronic distribution.

Rhoads (US 5,832,119) discloses a system for controlling systems control signals embedded in empirical data.

***Contact information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jayanti K. Patel whose telephone number is (703) 308-7728. The examiner can normally be reached on Monday-Friday (7:00-4:00), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on (703) 308-5246. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JKP



Jayanti K. Patel  
Primary Examiner

February 11, 2004